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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/846,025

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Philip M. Ginsberg

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02/24/2009

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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

02/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------|-----------------|--|
| <i>Office Action Summary</i> | Application No. | Applicant(s) | |
| | 09/846,025 | GINSBERG ET AL. | |
| | Examiner | Art Unit | |
| | Corbett B. Coburn | 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13, 15 and 56-65 is/are pending in the application.
4a) Of the above claim(s) 56-61 and 63-65 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11, 13, 15, 61 and 62 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it does not describe the elected invention. Correction is required. See MPEP § 608.01(b).
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Appropriate correction is required.

Information Disclosure Statement

3. The information disclosure statement filed 29 September 2008 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein (for the documents that were not provided) has not been considered.

Claim Objections

4. It appears from Applicant's specification that Applicant contemplates implementing the claimed method on a computer system. This is, however, not affirmatively claimed. Examiner urges Applicant to review *In re Bilski* & to make any amendments to the claims necessary.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 13, 15 & 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilms (US Patent Number 5,277,424).

Claims 11, 13: Wilms teaches a method of real-time interactive wagering on event outcomes – the player may wager in real time on the outcome of a slot machine game. Wilms teaches determining a wagering limit for the client – the number of credits available (16). Wilms teaches selecting wagerable event outcomes on which said client is authorized to wager – each game is a wagerable event outcome and each denomination is a different game. Each event outcome has a minimum required wager associated therewith – the \$1 game has a minimum required wager of \$1. The 25¢ game has a minimum required wager of 25¢. The client is only allowed to select event outcomes that do not exceed the wagering limit. Players may not bet more money than they have in credits. Fig 1 shows displaying the selection of wagerable event outcomes and when the player makes a selection (with button 24), this is receiving a request from the client to wager on one of said selection of wagerable event outcomes. As a player places a wager, it is subtracted from the available credits (i.e., the wagering limit) and placed in the Bet register. This is adjusting substantially immediately said wagering limit of said client.

Wilms does not teach only showing those wagers that cost less than or equal to the wagering limit. Displaying wagers a player cannot make might cause confusion. A player might, for instance, attempt to wager \$1 when he only had 95¢. Removing the \$1 wager from the screen is well within the level of ordinary skill & would yield predictable results. Furthermore, it would reduce the risk of confusion. It would have been obvious

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to one of ordinary skill at the time of the invention to have modified Wilms to only display those wagers that cost less than or equal to the wagering limit in order to reduce the risk of player confusion.

With respect to claim 13, each time the player plays the game, the credit limit reflects the results of the previous game.

Claim 15: Wilms teaches paying said client in a currency chosen by said client in response to the maturity of successful wager. By placing money into the slot machine, the player is choosing the currency. If the player wins, the machine pays the winnings.

Claim 61: The price of the wager varies – there are five prices to choose from. As noted above, it is obvious to display the list of available wagers based on which the player can actually afford to play.

Claim 62: It is obvious to adjust the list of available wagers whenever any wager is to be made (i.e., in real time).

Response to Arguments

7. Applicant's arguments filed 9 January 2009 have been fully considered but they are not persuasive.

8. With respect to the date of the parent application, Examiner notes that the originally filed specification included the entire date. The published application is in error.

9. With respect to the other objections to the specification, Examiner wishes to point out that having the title & the Abstract describe the Applicant's invention serves the interests of the entire patent community by making it easier for Examiners to determine if pertinent.

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10. With respect to the rejection under 35 U.S.C. § 112, 1st paragraph, Examiner notes that the specification does provide support for claim 11. Therefore, the rejection is withdrawn.

Claim 63 is withdrawn from consideration, so the issue of whether it is enabled is not yet ripe.

However, the specification clearly describes two alternate embodiments -- one with a list as described in claim 11 & a separate embodiment with a list including a popular wager, a reference wager, etc. Since these are described as alternate embodiments in the specification, the method of Claim 63 is not described in the specification.

11. With regard to claims 11 & 61, Applicant has cited a great number of court cases, but has failed to cite the most recent case on point – *KSR v. Teleflex*. The *KSR* case adjures examiners to apply common sense. Furthermore, it tells us that we must avoid formulaic approaches to the question of patentability & look at what would be obvious to one of ordinary skill.

12. There are a myriad of real-time events upon which a player may wager. As Applicant points out in his specification, some of these wagers cost more than others. Some of these wagers cost so much that a particular player cannot participate in them. But if all of the universe of wagers is listed, there is a potential for the player to be confused about which wagers he may participate in & which cost too much. Furthermore, a player is likely to be discouraged if he selects a number of potential wagers only to be told in each case that he cannot participate because he hasn't enough money. This might well lead the player to decide to take his money elsewhere. Thus game designers have a huge incentive to make the game as easy to use as possible. Obviously, one way to do this is to list only those wagers that a player can afford to make.

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13. Nor can anyone argue that restricting the displayed list in this manner is beyond the level of ordinary skill. It is, after all, merely a query of a database. Finally, the result of displaying only those wagers that a player could afford is predictable – i.e., a list of wagers that do not exceed a certain threshold. Since the modification uses known methods that are within the level of ordinary skill to arrive at a predictable result, the Examiner concludes that the modification is obvious. This is especially true given that there is a strong economic motive for making the change.

Conclusion

1. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
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